

REMARKS

Claims 1-26 were pending in the application. Claims 18-21 and 26 have been amended. Claims 17 and 22 have been canceled. No claims have been added. Therefore, claims 1-16, 18-21 and 23-26 are now pending in the application. Reconsideration of the application is requested for at least the reasons that follow.

Claim 18 has been rewritten into independent format.

Claims 19-21 and 26 have been amended to correct a minor informality.

35 U.S.C. 112, ¶ 1 Rejection

Claims 7 and 19 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants respectfully disagree with the rejection of claims 7 and 19. Support for the claims may be found in original claims 7 and 19. Further, claims 7 and 19 call for the scraper moving “in a reciprocating manner,” which is sufficiently described in the specification. For example, the specification states that the scraper moves radially inward and then moves “along the bottom of the recessed area” to scrape ink out of the spittoon. Application at p. 8, line 26. The scraper “moving along the bottom” of the recessed area is moving in a “reciprocating” manner. The specification has been amended to include “in a reciprocating manner” as described in original claims 7 and 19. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-16 and 23-25: Klausbruckner, Steinfield, Gaylor and Phillips

Claims 1-6, 9-14, 16 and 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,663,215 (“Klausbruckner”) in view of U.S. Patent No. 6,508,552 (“Steinfeld”). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Klausbruckner and Steinfield in view of U.S. Patent No. 6,764,160 (“Phillips”). Claims 7 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klausbruckner and Steinfield in view of U.S. Patent No. 6,340,220 (“Gaylor”). Applicants respectfully request reconsideration and withdrawal of the rejections for at least the following reasons.

The rejection should be withdrawn at least because the references, taken together or separately, fail to teach or suggest “a heater arranged to heat ink received in said spittoon,” as recited in claim 1. The Office Action correctly states that Klausbruckner does not disclose “a heater arranged to heat ink” or “means for heating ink received in said spittoon.” Office Action at p. 4, lines 1-3. Steinfield does not disclose a heater “arranged to heat ink received in said spittoon.” Rather, the heater 260 of Steinfield is configured to merely heat ink marks on recording media, not heat ink in a spittoon. *See* Steinfield at Abstract.

Furthermore, there is no motivation to combine the references as suggested by the Office Action. The Examiner contends that Steinfield discloses a heater to heat ink and that it would have been obvious to “modify the spittoon of Klausbruckner et al. for the benefit of drying the ink to fix the ink to the spittoon.” Office Action at p. 4, lines 10-11. However, the Examiner’s contention is not supported by the teachings of Klausbruckner and Steinfield. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, and not based on Applicants’ disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See also* MPEP § 2142. The Examiner’s motivation is not found in the prior art. The heater 260 of Steinfield is configured to heat ink marks on recording media in order to fix the ink marks to the recording media. The heating arrangement of Steinfield, since the arrangement is to fix ink to recording media, must occur immediately after the ink is fired onto the print media to dry the ink. Further, there is no disclosure in Steinfield regarding minimizing ink waste spills, rather Steinfield merely discloses fixing ink to paper. In contrast, only the present application identifies a problem with conventional spittoons and the ink located therein and suggests the desirability of quickly dried ink waste product. The heater in the present application is used to permit an enhanced reduction in the volume of the waste product, to permit a higher rate of spitting from the printheads, and/or to permit a reduction in the risk of contamination of the hardcopy device. *See* Application at p. 3, lines 14—18. Thus, the rejection is clearly based on impermissible hindsight reasoning and there is no basis for the combination relied upon by the Examiner.

Furthermore, there is not motivation to combine the references. A proposed modification cannot render the prior art unsatisfactory for its intended use. *See* MPEP at 2143.01(V). Adding the heater of Steinfield to the apparatus and spittoon of Klausbruckner would not be desirable because the spittoon is an absorbent block. Drying the ink in the spittoon with a heater may prevent the absorbent block from operating as intended. Thus, there is no motivation to add the heater of Steinfield to the spittoon/absorbent block of Klausbruckner. Therefore, the rejection should be withdrawn.

Additionally, Phillips and Gaylor fail to cure the deficiencies of Klausbruckner and Steinfield, taken together or separately.

Claims 2-10 and 23-25 depend from claim 1 and are allowable therewith, for at least the reasons set forth above, without regard to the further patentable subject matter set forth in these dependent claims.

For example, claim 5 requires a “scraper being spaced from said printhead circumferentially around said drum.” Klausbruckner merely discloses a wiper 54 to clean a printhead 50. *See* Klausbruckner at Col. 5, lines 55-58. The wiper 54 of Klausbruckner is not disposed away from the printhead and “circumferentially around said drum,” but rather, the wiper 54 is directly opposite the printhead 50 so that the wiper 54 may clean the printhead 50. *See* Klausbruckner at Fig. 6. Steinfield does not cure the deficiencies of the Klausbruckner. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 5.

Further, claim 23 requires “a scraper attached to a chassis and spaced circumferentially around said drum and away from said printhead.” The scraper of Klausbruckner is not spaced “away from said printhead.” Rather, the scraper remains below the printhead in a groove in the drum. *See* Klausbruckner at Figs. 1 and 2. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 23.

Independent claims 12 and 14 include recitations similar to claim 1. For example, claim 12 requires “a heater for said spittoon” and claim 14 requires “firing ink from said

printhead into said spittoon; and heating said ink,” and, therefore, for at least the reasons cited above, Applicants respectfully request reconsideration and withdrawal of the rejections.

Claim 13 depends from claim 12 and claims 15-16 depends from claim 14 and, thus, are allowable therewith, for at least the reasons set forth above, without regard to the further patentable subject matter set forth in these dependent claims.

Claims 17-22 and 26: Gaylor & Klausbruckner & Steinfield

Claims 17-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaylor in view of Klausbruckner. Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaylor, Klausbruckner and Steinfield. Claims 17 and 22 have been canceled. Claim 18 has been rewritten into independent form.

The rejection of claim 18 should be withdrawn at least because Gaylor and Klausbruckner fail to teach or suggest a “removal device [that] is movable in a circumferential direction and parallel *relative* to the circumferential surface of said drum,” as required by claim 18. Gaylor discloses a transferring spittoon system with a scraper 120 and a spit wheel 90. The scraper 120 of Gaylor does not move. Rather, the wheel 90 moves. *See* Gaylor at Col. 8, lines 59-62.

Klausbruckner does not cure the deficiencies of Gaylor. The Office Action states that the scraper of Klausbruckner moves “in a circumferential direction as the drum rotates.” However, any movement of the scraper of Klausbruckner that moves with the drum is not movement “*relative to the circumferential surface*” of the drum. In Klausbruckner, the scraper can move forwards and backwards along the depth of the drum or move (as it must) when the drum rotates; neither of which are circumferential movements relative to the circumferential surface of the drum. In addition, Steinfield does not cure the deficiencies of Gaylor and Klausbruckner. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 19-21 and 26 depend from claim 18 and are allowable therewith, for at least the reasons set forth above, without regard to the further patentable subject matter set forth in these dependent claims.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application, as amended, is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date June 2, 2006

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